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#8
11-8-99

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :

Rhona H. BORTS et al. : Docket No. 00263/PP/NT/PH/1165 US

Serial No. 09/155,452 : Group Art Unit 1649

Filed October 23, 1998 : Examiner O. Zaghmout

MEIOTIC RECOMBINATION IN VIVO OF PARTIALLY HOMOLOGOUS DNA SEQUENCES :

RESPONSE TO RESTRICTION

Assistant Commissioner for Patents,
Washington, D.C. 20231

Sir:

Responsive to the Restriction Requirement dated July 28, 1999, the time for responding being extended for two months in accordance with a Petition for Extension submitted concurrently herewith, Applicants respectfully elect Group I, claims 1-8 and 10, with traverse.

Applicants believe that the Examiner's Restriction Requirement is improper under U.S. practice. Under § 809.02(a) of the Manual of Patent Examining Procedure (MPEP), the Examiner must identify generic claims (i.e., "independent or distinct" genuses) present in the present application. In reviewing claims 1-10 of the present application, only 1 independent and generic (or genus) claim is present and is directed to all eukaryotic cells. In claims 4 and 9, the eukaryotic cells are further limited to the particular species of unicellular organisms and plants.

It is clear based on § 806.04(d) of the MPEP that claim 1 satisfies the definition of a generic claim. Specifically, claim 1 does not include any material element additional to those recited in the specie claims. Further, the claim comprehends within its confines the organization covered in each of the species. Thus, based on the guidelines provided by the MPEP, the present claims define a single invention encompassing the same essential characteristics (i.e., eukaryotic).

Since the claims of the application define the same essential characteristic of a single disclosed embodiment of an invention, restriction there between as instructed in § 806.03 of the MPEP, should not be required. In other words, the specie claims outlined in claims 4 and 9 are different definitions of the same disclosed subject matter which only vary in breadth or scope of definition. The Examiner has improperly separated generic claim 1 into 2 genuses (non-plant eukaryotic cells and plant eukaryotic cells). However, the Examiner is not permitted to separate the subject matter of claim 1 since generic claim 1 does not separately recite plant and non-plant eukaryotic cells. The Examiner is not allowed under U.S. practice to arbitrarily separate one generic claim into two different genuses if the claims do not make such a differentiation.

In actuality, based on the Applicants' review of Chapter 800 of the MPEP, the Examiner is essentially requesting a species election (non-plant eukaryotic and plant eukaryotic) of a genus claim (eukaryotic) and not a genus election.

Thus, since there contains only one generic claim and thus, one genus in the application, the restriction requirement set forth by the Examiner is improper under U.S. practice. As a result,

the Examiner is respectfully requested to withdraw the restriction requirement in accordance with U.S. practice.

Respectfully submitted,

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